

## **REMARKS**

In response to the Office Action dated May 7, 2003, applicants submit the following amendments and remarks for entry of record in the above-identified patent application.

Before addressing the specific grounds of rejection, applicants have canceled Claims 5 and 26, without prejudice or disclaimer. Applicants have also amended Claims 1, 4, 6-8, 12, 13, 16, 17, 19, 20-22, 25, 27, 29, 32, and 33, and amended the specification in the manner indicated above.

In the present Office Action, the specification is objected to for certain informalities. Claims 1, 4, 12, 15-17, 19-22, 24-26, 32, 33 and 36 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Additionally, Claims 1-3, 9, 11, 12 and 16 stand rejected, under 35 U.S.C. §102(b), as allegedly anticipated by U.S. Patent No. 5,990,206 to Tanaka, et al. (hereinafter "Tanaka, et al."). Claims 1-3, 9, 11, 12, 16-24, 30, 32 and 33 stand rejected, under 35 U.S.C. §103(a), as allegedly obvious over Tanaka, et al. in view of the ordinary skill in the art at the time the invention was made. Claims 5-8, 10, 13-14, 27-29, 31, 34 and 35 stand objected to as dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Referring to the objection to the specification, it is the Examiner's position that the term "compatilizer" should be "compatibilizer". Although applicants note that the terms "compatilizer" and "compatibilizer" convey the same meaning to one of ordinary skill in the art, applicants have amended the specification to recite "compatilizer" for the purposes of advancing prosecution.

Referring to the 35 U.S.C §112, second paragraph, rejections of Claims 1, 4, 16, 17, 19-22, and 25 it is the Examiner's position that the term "compatilizer" should be "compatibilizer". In response to the Examiners' comments and for the purposes of advancing prosecution, applicants have amended Claims 1, 4, 16, 17, 19, 20-22 and 25 to replace "compatilizer" with "compatibilizer". In light of the amendment to Claims 1, 4, 16, 17, 19-22, and 25 the instant §112 rejection has been obviated. Withdrawal thereof is respectfully requested.

Claim 15 stands rejected under 35 U.S.C. §112, second paragraph, for reciting the term "derivative". Definiteness of claim language must be analyzed, not in a vacuum, but in light of the claim interpretation that would be given by one possessing the ordinary skill in the art at the time the invention was made. *See Soloman v. Kimberly Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). Applicants submit that Claim 15 clearly and distinctly claims that binary aldehydes are *p*-phthalic aldehyde and its derivatives or *m*-phthalic aldehyde and its derivatives. One skilled in the art would recognize that the term "derivative" as recited in Claim 15 denotes a substance that is structurally related to *m*-phthalic aldehyde or *p*-phthalic aldehyde; i.e., *m*-phthalic amide or *p*-phthalic

amide. Therefore, Claim 15 clearly and distinctly claims an aspect of the present invention. Applicants respectfully request that the instant rejection under 35 U.S.C. §112, second paragraph, be withdrawn.

Claim 16 stands rejected under 35 U.S.C. §112, second paragraph, for allegedly claiming a method under undefined conditions. Applicants have amended Claim 16 to further define applicants' claimed method. Amended Claim 16 clearly and positively recites one aspect of applicants' claimed process for preparing a storage-stable modified asphalt composition which *is performed at 100°C to 250°C to react for 5 to 300 minutes, wherein said cross-linking reagent is one selected from the group consisting of crystallized sulfurs, activated sulfurs, sulfur-donors, and "symbolizing" sulfur-donating cross-linking reagents, or a mixture thereof.* Support for the amendment to Claim 16 is found throughout the originally submitted specification; i.e., at page 7 lines 22 –24 and page 8 lines 6-8. Applicants submit that in light of the amendment to Claim 16 the instant rejection has been obviated and respectfully request that the rejection be withdrawn.

Claims 12, 32 and 33 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly containing improper markush language. In response to the Examiner's comments and for the purposes of advancing prosecution, applicants have amended the claims 12, 32 and 33 to provide proper markush format. In light of the amendment to Claims 12, 32 and 33, applicants submit that the instant rejection under 35 U.S.C. §112, second paragraph, has been obviated, and respectfully request that the rejection be withdrawn.

Before addressing the prior art rejections under 35 U.S.C. §102 and 35 U.S.C. §103, applicants have amended independent Claims 1 and 16 in a manner deemed allowable by the Examiner. Referring to page 5 of the present Office Action, it is the Examiner's position that the Claims 5-8, 10, 13, 14, 27-29, 31, 34 and 35 are allowable as rewritten in independent form, including all of the limitations of the base claim and any intervening claims.

Applicants have amended Claim 1 to include the subject matter deemed allowable by the Examiner in Claim 5. More specifically, Claim 1 has been amended to clearly and positively recite applicants' asphalt composition which includes a cross-linking agent that is *selected from the group consisting of crystallized sulfurs, activated sulfurs, sulfur-donors, and "symbolizing" sulfur-donating cross-linking reagents, or a mixture thereof*. As a consequence of the amendment to Claim 1, Claim 5 has been cancelled. Moreover, the dependencies have been amended to reflect the same.

Applicants have also amended Claim 16 to include the subject matter deemed allowable by the Examiner. More specifically, Claim 16 has been amended to clearly and positively recite applicants' process for preparing a storage stable modified asphalt composition which includes a cross-linking agent that is *selected from the group consisting of crystallized sulfurs, activated sulfurs, sulfur-donors, and "symbolizing" sulfur-donating cross-linking reagents, or a mixture thereof*. As a consequence of the amendment to Claim 1, Claim 5 has

been cancelled. Moreover, the dependencies have been amended to reflect the same.

Applicants respectfully submit that amended independent Claim 1, together with dependent composition Claims 2-4 and 6-15, and independent claim 16, together with dependent process Claims 17-25 and 27-36, are all allowable.

With respect to the rejection under 35 U.S.C. §102 and 35 U.S.C. §103, Claims 1-3, 9, 11, 12 and 16 stand rejected as allegedly anticipated by Tanaka, et al., and Claims 1-3, 9, 11, 12, 16-24, 30, 32 and 33 stand rejected as allegedly obvious over Tanaka, et al. in view of the ordinary skill in the art at the time the invention was made. Applicants submit that the above rejections applying Tanaka, et al. are moot as a consequence of the amendments provided herein. Accordingly, the rejections of Claims 1-3, 9, 11, 12, 16-24, 30, 32 and 33 are overcome and withdrawal thereof is respectfully requested.

Applicants submit that the currently amended Claims are in condition for allowance, which action is earnestly solicited.

Respectfully Submitted



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